

**REMARKS**

Claims 1-7 and 13-18 are pending in this application. Claims 1-7 and 13-18 stand rejected. By this Amendment, claims 1 and 2 have been amended. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicants respectfully submit that each of the pending claims is in immediate condition for allowance.

Claims 1-7 and 13-18 stand rejected under 35 U.S.C. § 102(a) or alternatively under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,558,273 ("Kobayashi"). Applicants respectfully traverse these rejections.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art

references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicants.

Among the limitations of independent claims 1 and 2 not present in the cited reference is “the face member is subjected to a heat treatment process, including an aging treatment, prior to a welding processing, in which the other members of the golf club head are welded to the face member.”

Kobayashi discloses a process for manufacturing a golf club head comprising the steps of:

- i) producing an ingot from an alloy material of required composition by means of arc welding;
- ii) forming the ingot into plate materials of a preset thickness by means of hot and cold rolling;
- iii) fabricating members of respectively preset shapes, i.e., the face member 16, body member 17 and crown member 18, by means of hot or cold pressing and then assembling these members into the head 1 by joining them together by welding; and
- iv) subjecting the head thus obtained to aging treatment.

Thus, in Kobayashi, the aging treatment is performed after the club head is assembled by welding the other members, such as body member 17 and the crown member 18 to the face member 16. See, Kobayashi col. 7, ln. 63 - col. 8, ln. 7.

In contrast, the present claims recite a metal golf club head wherein the hardness of the metal itself differs at the center portion and at the peripheral portion of the face. To obtain the above feature, the face member of the present invention is subjected to the heat treatment process, such as the aging treatment, prior to the welding process, in which the other members of the golf club, such as the sole, the crown, and the hosel members, are welded to the face member. The hardness of the face member is first, increased as a whole due to the heat treatment process. After the face member is subjected to the heat treatment process, the other members are welded to the face member at its peripheral portion to form the golf club head.

In this process, the hardness of only the peripheral portion of the face member is decreased by the heat applied during the welding process compared to when it is subjected to the above heat or aging treatment. As a result, the central portion of the face member maintains its hardness from the heat or aging treatment while the peripheral portion of the face member has the hardness lower than the central portion due to the subsequent welding step. The explicitly recited limitation of the invention described above is thus obtained.

In summary, the Kobayashi's club head is, subjected to the aging treatment after the assembly of the entire club head is completed. No disclosure is made in Kobayashi that the aging treatment is performed prior to the welding

process in which the other members of the golf club are welded to the face member. As is disclosed in Kobayashi, even if the aging treatment is carried out after assembling the club head is completed, it seems to be difficult to obtain the face member in which the hardness of the peripheral portion of the face member is lower than that of the central portion. Therefore, Kobayashi does not disclose or suggest the feature of the invention.

Claims 3, 5, 7, 13-15, and 18 depend either directly or indirectly from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Kobayashi and are also believed to be directed towards the patentable subject matter. Thus, claims 3, 5, 7, 13-15, and 18 should also be allowed.

Claims 4, 6, 16, and 17 depend either directly or indirectly from, and contain all the limitations of claim 2. These dependent claims also recite additional limitations which, in combination with the limitations of claim 2, are neither disclosed nor suggested by Kobayashi and are also believed to be directed towards the patentable subject matter. Thus, claims 4, 6, 16, and 17 should also be allowed.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly,

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the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

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